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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,987	03/11/2004	Roland Ramin	08048.0047-00	4626
22852 7590 04/17/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER JACKSON, MONIQUE R	
			ART UNIT	PAPER NUMBER
			1773	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/17/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/796,987

Applicant(s)

RAMIN ET AL.

Examiner

Monique R. Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35,37-70,72-81 and 83-97 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35,37-70,72-81 and 83-97 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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Claim Rejections - 35 USC § 102

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/29/07 has been entered. Claims 36, 71 and 82 have been cancelled. Claims 1-35, 37-70, 72-81, and 83-97 are pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Objections

3. Claim 35 objected to because of the following informalities: in line 2, the claim recites "and and" – the second "and" should be deleted. Appropriate correction is required.
4. Claim 58 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 58 recites that the texturizing agent is present in an amount less than or equal to 10% by weight, however the parent claim 35 already recites the same range.
5. Claim 73 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 73 recites that the metallic glint particle is provided in an amount of greater than or equal to 2% by weight and the texturizing agent is present in an

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amount less than or equal to 10% by weight, however the parent claim 73 already claims the same ranges.

Claim Rejections - 35 USC § 112

6. Claim 41 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 41 recites the limitation, "The composition according to claim 40, wherein the at least one particle with metallic glint is present in an amount ranging from 2 to 20% by weight" however claim 40 recites that the amount is "greater than or equal to 7% by weight". Hence, Claim 41 contradicts claim 40 and it is unclear what amount of metallic glint particle is incorporated in the composition.

7. Claims 63 and 79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 63 recites that the "at least one film-forming polymer is present in an amount ranging from 0.1 to 15% by weight" however the parent claim 35 recites that all texturizing agents are present in an amount less than or equal to 10% by weight. Hence, Claim 63 contradicts claim 35 because it includes values greater than 10% ("to 15%") and it is unclear what amount of film-forming polymer/texturizing agent is actually incorporated in the composition. Similarly, Claim 79 recites "at least one texturizing agent present in an amount of less than or equal to 15% by weight" in the first composition however the parent claim 72 recites an endpoint of 10%.

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Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-3, 5-18, 21-35, 37-39, 41-53, 56-70, 72-81, and 83-97 are rejected under 35 U.S.C. 102(e) as being anticipated by Socci et al (USPN 6,565,835.) Socci et al teach a nail enamel composition for coating natural or synthetic human nails comprising one or more film forming components, one or more solvents, and aluminum particles in the form of platelets to provide a dried film having a mirrorlike appearance (Abstract.) Socci et al teach that the film forming component is selected from higher molecular weight polymers, such as nitrocellulose with a molecular weight of greater than 56,000, enabling a lower total solid content of the nail enamel composition, in the order of about 4 to about 20% by weight of the composition, wherein the content of the film forming component or mixture thereof ranges from about 2 to about 15% by weight, preferably about 4 to about 8% by weight (Col. 2, line 60-Col. 3, line 3; Col. 3, lines 19-21; Col. 4, line 12-Col. 5, line 4.) Socci et al teach that the composition may be applied to a base coat of a base coat nail enamel composition, as disclosed in U.S. application 09/327799, now USPN 6,139,822, incorporated by reference, which reads upon the claimed “second composition” including comprising preferably about 10 to 15% by weight of film forming polymers and includes a thickening (Col. 2-5; examples and claims of 6,139,822.) Socci et al teach that the platelets have an aspect ratio of between about 1.0 to 5.2 and a length in the range

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of about 3.6 to 45.3 microns and are provided in an amount of about 0.1 to about 5% by weight of the composition (Col. 3, lines 47-50; Col. 6, lines 29-33.) Socci et al disclose various film forming polymers at Col. 4, lines 12-25 as well as various additives that may be incorporated into the composition including additional secondary pigments or colorants, and also disclose suitable solvents in an amount of 80-96% by weight, preferably 85-90% by weight (Col. 4, line 12-Col. 5, line 64; Col. 6, lines 34-55.) With respect to Claims 35, 80, 89, 94, though Socci et al do not specifically teach the wear resistance as instantly claimed, the Examiner takes the position that the nail enamel composition taught by Socci et al reads upon the claimed invention in that it is "capable" of forming a film with the claimed wear resistance, given that it comprises the same components as the instantly claimed composition in the same amounts.

Claim Rejections - 35 USC § 103

10. Claims 4, 19-20, 40, and 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Socci et al. The teachings of Socci et al are discussed above. Though Socci et al teach that the aluminum particles are preferably platelets, Socci et al do not specifically teach the "shape factor" as instantly claimed. However, given that Socci et al teach the use of platelets, one skilled in the art at the time of the invention would have been motivated to utilize any form of commercially available aluminum platelets and determine the optimum "shape factor" to provide the desired coating and aesthetic properties for a particular end use. Further, though Socci et al teach that the aluminum platelets are preferably provided in an amount of about 5% by weight, one skilled in the art at the time of the invention would have been motivated to utilize routine experimentation to determine the optimum amount of aluminum particles to provide the desired aesthetic properties or mirrorlike appearance, wherein an amount of 7wt% as in instant claims 4

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and 40 is close enough to the "about 5% by weight" disclosed in Socci et al to have been obvious to one skilled in the art at the time of the invention.

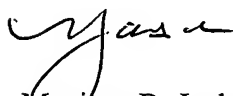
Response to Arguments

11. Applicant's arguments filed 1/29/07 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R. Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Monique R. Jackson
Primary Examiner
Technology Center 1700
April 16, 2007